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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,578	07/26/2000	TADASHI KURIYAMA	106336	9483
25944	7590	10/27/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER EGAN, BRIAN P	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,578

Applicant(s)

KURIYAMA ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-8 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 6-8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowman (GB 2,259,291 A) in view of Romagnoli (#4,060,168) and Volkman (#5,238,720).

Lowman teaches a plastic container (Fig. 1, #10) with a tack label comprising a label base material (p.4, lines 7-9), a printing layer formed on a first surface of the base material (p.2, lines 10-12), and an adhesive layer formed on a second surface which opposes the first surface of the label base material (p.1, line 24 to p.2, line 2), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (see Abstract; p.2, lines 20-26; p.3, lines 12-15). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (see Abstract). The adhesive layer comprises an acrylic water-soluble adhesive (p.2, lines 23-26) and the base label material comprises a material (paper) whose specific gravity is less than one (p.2, lines 17-19; see Also *On the Distribution of Mass, Thickness, and Density in Paper*, Fig. 2, page 4, for verification of the density of paper (0.4-0.85 g/cm³)). Although Lowman does not explicitly state that the tack label is peeled from a container body within 30 minutes when

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the container body is submersed in 75 degrees Celsius hot water and that the tack label is not easily peeled from the container body in a lapse of 30 minutes after the container body is immersed in 40 degrees Celsius water, the aforementioned limitation is inherently met since Lowman discloses the same adhesive material composition as the claimed invention, therefore rendering the material properties inherently consistent.

Lowman fails to teach the use of a masking layer that is situated in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer wherein a masking layer may also be placed on a portion of the edge of the adhesive layer.

Romagnoli, however, teach a label construction that is applied to bottles wherein a masking layer ("cut portion") is formed in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer and where a second masking layer (and optionally third (i.e., the tab portion)) is formed in only a part of the edge portion of the adhesive layer (see Fig. 7, #s 22, 23, and 34; Col. 3, lines 20-31).

Although Figure 7 depicts a second masking layer that extends beyond the periphery of the adhesive layer, Romagnoli state that in reference to Figure 7, "cut portion 22 may include a projection section 32 which extends beyond the edge of the label 16 (Col. 3, lines 24-26)." The phrase "may include" is inclusive of embodiments that do and do not comprise a projection section. Therefore, Romagnoli teach a masking layer formed at only a part of an edge of the adhesive. In further support of the aforementioned contention, it is notoriously well known in the art to form a masking layer at only a part of an edge of the adhesive as evidenced by Volkman (Col. 4, lines 57-66). Romagnoli does not explicitly state that the masking layer portions comprise between 5 and 90% of

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the adhesive surface area, although Romagnoli does teach that the masking portions may be any desired shape (Col. 3, lines 3-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the percent surface area coverage of the masking layers based on the desired shape of the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the percent surface area coverage of the masking layer by changing the shape of the masking components, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Also note that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Romagnoli teaches the use of the masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle (Col. 1, lines 42-50; Col. 3, lines 26-31 and 40-45). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified an adhesive label for a bottle by using masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle as taught by Romagnoli.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicants invention was made to have modified Lowman to include masking layer portions in the central area of the adhesive and along only a part of the peripheral edge of the adhesive as taught by Romagnoli in order to provide portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle.

3. Claims 1-2, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (#4,444,839) in view of Romagnoli (#4,060,168) and Volkman (#5,238,720).

Dudzik et al. teach a plastic container (Col. 1, lines 19-22) with a tack label comprising a label base material (Fig. 1, #1), a printing layer formed on a first surface of the base material (Fig. 1, #4), and an acrylic adhesive layer (Col. 2, lines 9-18) formed on a second surface which opposes the first surface of the label base material (Fig. 1, #2), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (see Abstract). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (see Abstract; Col. 1, lines 36-39). Dudzik et al. further teach that the label is not detached from the container by the action of condensation water, sprayed water, or rainwater or aqueous liquids below a temperature of 30°C, but can be detached and dissolved, without problems (i.e., easily peeled), using water which has a temperature of about 50°C (Col. 3, lines 3-10). Dudzik et al. further teach the removal step occurs at

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70°C (Col. 3, lines 44-52). Dudzik et al. ultimately define hot water as water at temperatures above 50°C and cold water as water at temperatures below 30°C (Col. 5, lines 12-14; Col. 1, lines 52-55).

Although Dudzik et al. teach the use of a masking layer (Fig. 1, #3), Dudzik et al. fail to teach the masking layer being cut such that a portion of the masking layer remains on the central or outside portions of the adhesive layer when applying the label to the bottle.

Romagnoli, however, teach a label construction that is applied to bottles wherein a masking layer (“cut portion”) is formed in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer and where a second masking layer (and optionally third (i.e., the tab portion)) is formed in the edge portion of the adhesive layer (see Fig. 7, #s 22, 23, and 34; Col. 3, lines 20-31). Although Figure 7 depicts a second masking layer that extends beyond the periphery of the adhesive layer, Romagnoli state that in reference to Figure 7, “cut portion 22 may include a projection section 32 which extends beyond the edge of the label 16 (Col. 3, lines 24-26).” The phrase “may include” is inclusive of embodiments that do and do not comprise a projection section. Therefore, Romagnoli teach a masking layer formed at only a part of an edge of the adhesive. In further support of the aforementioned contention, it is notoriously well known in the art to form a masking layer at only a part of an edge of the adhesive as evidenced by Volkman (Col. 4, lines 57-66). Romagnoli does not explicitly state that the masking layer portions comprise between 5 and 90% of the adhesive surface area, although Romagnoli does teach that the masking portions may be any desired shape (Col. 3, lines 3-5). Therefore, it would have been obvious to one of ordinary skill in the

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art at the time Applicant's invention was made to have modified the percent surface area coverage of the masking layers based on the desired shape of the end product.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the percent surface area coverage of the masking layer by changing the shape of the masking components, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Also note that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Romagnoli teaches the use of the masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle (Col. 1, lines 42-50; Col. 3, lines 26-31 and 40-45). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified an adhesive label for a bottle by using masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle as taught by Romagnoli.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicants invention was made to have modified Dudzik et al. to include cut

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masking layer portions in the central area of the adhesive and along the peripheral edge of the adhesive as taught by Romagnoli in order to provide portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle.

4. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (#4,444,839) in view of Romagnoli (#4,060,168) and Volkman (#5,238,720), and further in view of Freedman et al. (#6,165,576).

Dudzik et al., Romagnoli, and Volkman teach a tack label as detailed above. The aforementioned prior art fails to teach a label base material with a specific gravity of less than one.

Freedman et al., however, teach a peelable label that is used in combination with a recyclable bottle (see Abstract). Freedman et al. teach that the label base material has a material with a specific gravity of below 1 for the purpose of providing a label base material with a label base material sufficiently different than the specific gravity of the bottle material such that the two materials can be successfully separated from one another in a recycling operation (Col. 8, lines 30-40). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have selected label materials based on the specific gravity value of that material for the purpose of providing a label base material with a label base material sufficiently different than the specific gravity of the bottle material such that the two materials can be successfully separated from one another in a recycling operation as taught by Freedman et al.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the aforementioned prior art to include a label base material with a specific gravity of less than one as taught by Freedman et al. in order to provide a label base material with a label base material sufficiently different than the specific gravity of the bottle material such that the two materials can be successfully separated from one another in a recycling operation.

Response to Arguments

5. Applicant's arguments filed June 29, 2004 have been fully considered but they are not persuasive.

Again, the primary contentions set forth by the Applicant in the response as well as the interview dated July 2, 2004 were focused on Romagnoli ('168) not teaching the use of a masking layer only at a part of an edge of the adhesive. The Examiner agrees that Fig. 7 depicts an adhesive label with a masking portion "32" extending beyond the periphery of the adhesive sheet. The rejection, however, is tailored towards Romagnoli's disclosure that "cut portion 22 may include a projection section 32." The phrase "may include" is inclusive of embodiments exhibiting a projection section and embodiments without a projection section. Therefore, the embodiment without a projection section comprises a masking layer only at a part of an edge of the adhesive. Therefore, the Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have arrived at the Applicant's claimed invention in view of the prior art of record, including cited patent #5,238,720 to Volkman.

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Furthermore, in response to Applicant's arguments that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Here, it would have been obvious to one of ordinary skill in the art, reviewing the references of record as a whole, to arrive at the applicant's claimed invention. First, it is notoriously well known in the art as evinced by the primary references of record to provide tack labels with hot water soluble adhesives. Second, in accordance with the secondary references of record, it is notoriously well known in the art to provide masking layers in both the central portion of the label and along a portion of the edge of the tack label. There is clear motivation, both explicit and implicit, to provide masking portions to facilitate the peeling and removal of the tack label from a substrate. Therefore, taking the references as a whole, it would have been obvious to one of ordinary skill in the art to provide a tack label with water-soluble adhesive and multi-portioned masking layers as claimed by the applicant.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian P. Egan
10/18/04

Harold Y. Pyon
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1772

10/20/04